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United States Patent and Trademark Office  
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Alexandria, VA 22313-1450  
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JGJR.: 02-06

Paper No: \_\_\_\_

DELTAT GMBH  
KERKRADER STRASSE 11  
HESSEN 35394 DE GERMANY

**COPY MAILED**

**FEB 10 2006**

**OFFICE OF PETITIONS**

In re Application of	:	
Nehring, et al.	:	DECISION
Application No.: 10/022,406	:	
Filing Date: 20 December, 2001	:	
Attorney Docket No. (None)	:	

This is a decision on the petition filed on 1 June, 2005 (but the file was not received into the Office of Petitions until this writing) and considered as a request for the withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below the petition as considered under 37 C.F.R. §1.181 is  
**DISMISSED.**

**NOTES:**

- (1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)."

(It is noted, however, that Petitioner may be unable to present a satisfactory showing to support a petition under 37 C.F.R. §1.137(a), and Petitioner's only alternative will be to file a petition under 37 C.F.R. §1.137(b).)

- (2) Thereafter, there will be no further reconsideration of this matter.

### BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to a non-final Office action mailed on 23 June, 2004, with reply due absent extension of time on or before 23 September, 2004—a copy is enclosed for Petitioner's review;
- the application went abandoned after midnight 23 September, 2004;
- the Office mailed a Notice of Abandonment, indicating a failure to respond to the 23 June, 2004, Office action, on 20 May, 2005;
- Petitioner averred in the instant petition that the reason for the abandonment was that the Office had failed to process a payment from Petitioner to the Office—while it is true that the Office has not processed the addition payment, and Petitioner must resubmit the payment/authorization along with that for any renewed petition, the focus at this point also is Petitioner's failure to reply timely and properly to the 23 June, 2004, Office action.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

Allegations as to the Request to  
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>7</sup>

The commentary at MPEP §711.03(c) provides:

\* \* \*

**B. Petition To Withdraw Holding of Abandonment Based on  
Evidence That a Reply Was Timely Mailed or Filed**

37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as “Express Mail.” A petition to withdraw the holding of abandonment relying upon a timely reply placed in “Express Mail” must include an appropriate petition under 37 C.F.R. §1.10(c), (d), \* (e), or (g) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the “Express Mail” procedures, the paper must be entered in PALM with the

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<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>4</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>7</sup> See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

“Express Mail” date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. §1.8(b) and MPEP § 512. As stated in 37 C.F.R §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).

37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the

correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP § 512.

\* \* \*

Moreover, Petitioner has failed to respond to the Office action in question—thus, Petitioner has not satisfied the showing requirements described above.

### CONCLUSION

Because Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 hereby is **dismissed**.

### ALTERNATIVE VENUE

Petitioner's only alternative to irretrievable abandonment is a petition alleging unintentional delay under 37 C.F.R. §1.137(b).<sup>8</sup>

Petitioner may wish to file such a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay. (See: [http://www.uspto.gov/web/offices/pac/mpep/documents/0700\\_711\\_03\\_c.htm#sect711.03c](http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c) )

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply (the amendment), the petition fee, and a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional." (The statement is in the form provided and available online.)

Further correspondence with respect to this matter should be addressed as follows:<sup>9</sup>

By mail:        Commissioner for Patents<sup>10</sup>  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

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<sup>8</sup> The regulations at 37 C.F.R. §1.183 sets forth that waiver of the rules is "subject to such other requirements as may be imposed."

<sup>9</sup> On July 15, 2005, the Central Facsimile (FAX) Number changed to (571) 273-8300. The old FAX number no longer is in service and (571) 273-8300 will be the only facsimile number recognized for centralized delivery. (For further information, see: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf> .)

<sup>10</sup> To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at [www.uspto.gov](http://www.uspto.gov).

By FAX: IFW Formal Filings  
(571) 273-8300  
ATTN.: Office of Petitions

By hand: Mail Stop: Petition  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

Encl: Form: Petition alleging unintentional delay under 37 C.F.R. §1.137(b)  
Copy: The 23 June, 2004, Office action  
Copy: Notice of Abandonment

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT  
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)

First named inventor:

Application No.:

Art Unit:

Filed:

Examiner:

Title:

Attention: Office of Petitions  
**Mail Stop Petition**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION**

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

**1. Petition fee**

☐ Small entity-fee \$ \_\_\_\_\_ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee \$ \_\_\_\_\_ (37 CFR 1.17(m))

**2. Reply and/or fee**

A. The reply and/or fee to the above-noted Office action in the form of \_\_\_\_\_ (identify type of reply):

- ☐ has been filed previously on \_\_\_\_\_.
- ☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ \_\_\_\_\_.

- ☐ has been paid previously on \_\_\_\_\_.
- ☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

- ☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ \_\_\_\_\_ for a small entity or \$ \_\_\_\_\_ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

**WARNING:**

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Date

\_\_\_\_\_  
Typed or printed name

\_\_\_\_\_  
Registration Number, if applicable

\_\_\_\_\_  
Address

\_\_\_\_\_  
Telephone Number

\_\_\_\_\_  
Address

Enclosures: ☐ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unintentional delay

☐ Other: \_\_\_\_\_

**CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]**

I hereby certify that this correspondence is being:

- ☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.
- ☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (571) 273-8300.

\_\_\_\_\_  
Date

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Typed or printed name of person signing certificate

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## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
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Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,406	12/20/2001	Dirk Nehring		5065

7590 05/20/2005  
deltaT GmbH  
Kerkraeder Strasse 11  
Hessen, 35394  
GERMANY

EXAMINER

SODERQUIST, ARLEN

ART UNIT PAPER NUMBER

1743

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notice of Abandonment**

Application No.

10/022,406

Examiner

Arlen Soderquist

Applicant(s)

NEHRING ET AL.

Art Unit

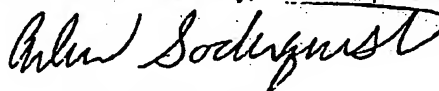
1743

**- The MAILING DATE of this communication appears on the cover sheet with the correspondence address-**

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 23 June 2004.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☒ A reply was received on 20 September 2004 but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$ \_\_\_\_\_ is insufficient. A balance of \$ \_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$ \_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$ \_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

Applicant has failed to correct the deficiencies noted in the of notice of fee deficiency, mailed September 24, 2004.



ARLEN SODERQUIST  
PRIMARY EXAMINER

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,406	12/20/2001	Dirk Nehring		5065

7590 06/23/2004  
DIRK NEHRING  
VERSAILLER STR. 1  
GIESSEN, HESSEN, 35394  
GERMANY

EXAMINER

SODERQUIST, ARLEN

ART UNIT PAPER NUMBER

1743

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/022,406

Applicant(s)

NEHRING ET AL.

Examiner

Arlen Soderquist

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on October 10, 2001. It is noted, however, that applicant has not filed a certified copy of the 0124070.2 application as required by 35 U.S.C. 119(b).

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the clip for sealing the two double walled shells, the outside locking mechanism of claim 11, the eyelet of claim 14, the movable hinge of claim 17, the carrying strap of claim 18 and the thermometer of claim 19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The disclosure is objected to because of the following informalities: on page 4 of the specification, the last two sentences refer to claim 1 and the claim in an improper manner. The claims are to rely on the disclosure in the specification and drawings for their support. Additionally the disclosure is not supposed to change after the application has been filed. Since the claims often change during the processing of an application, statements in the specification that rely on the claims as are found in these two sentences would cause the disclosure to be changed as the claims change. For that reason the reference to the claims is improper.

Appropriate correction is required.

4. Claims 2-3 and 12-14 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited. It is not clear what structure constitutes a clip (the sealing tie mentioned on page 6 of the specification but not shown in the figures or another structure?) or an eyelet.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-7 and 9-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bruce (US 5,235,819). In the patent Bruce teaches an apparatus for storing and distributing materials. The apparatus maintains products at an intended temperature during transport and storage at an ambient temperature deviating from the intended temperature. The invention features a container that holds the products and whose walls render heat transfer difficult. The container includes a main container body with a bottom and a side section that together define one or more integrated compartments (a double walled structure) suitable for storing a solidifiable substance. The container includes a lid which also has an integrated compartment for storing a solidifiable substance. When the lid is positioned on the main container body there is provided a solidifiable substance confinement enclosing the material storage space in the container from all sides. By subjecting the container and the solidifiable substance in its wall compartments (4, 4') to cold, so as to solidify the substance, subsequently inserting the products into the container after it has been moved to a room having a temperature adapted to the products, and positioning the lid over the container main body, an uninterrupted layer of solidifiable substance is provided around the entire material storage space. Column 2, lines 22-38 teach that water is one possible medium that is especially suited for materials which are to be maintained at 0 °C. or material to be maintained at a predetermined temperature below 0 °C, an additive such as salt can be added to lower the freezing temperature of the freezable substance.

Moreover, in situations when it is desirable to maintain the temperature of the product above 0°C, such as for a live lobster or blossoming flower products, a solidifiable substance having a higher solidification temperature is utilized. For example, paraffin hydrocarbon compounds such as tetradeceane, pentadeceane and hexadeceane with solidification temperatures of 5.8°, 9.7° and 18.0 °C, respectively, can be relied upon. Various hydrocarbon alcohol compounds are also possible. Column 5, lines 35-40 teach that if added protection is deemed desirable, sealing means such as an elastomeric seal placed between rim 36 and flange 62 or interengaging molded surfaces (e.g., saw tooth, labyrinth) can be provided in the contacting surfaces of flange 62 and upper edge 36. Column 6, lines 17-28 teach that a suitable material for the main body container and lid includes HO polyethylene or polypropylene (transparent materials) as it is durable for handling the rough treatment associated with freight carrying and is sufficiently adaptable to handle the explosive effect of some of the solidifiable substance usable in the compartments. Such material can easily be injection molded to form the components of the present invention. If the container of the present invention is to be strictly used with a solidifiable substance that does not expand upon solidification then a less flexible material such as aluminum sheet metal can be relied upon. Table 1 shows a variety of compositions for the solidifiable material including a saline solution and paraffins.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 2-3, 12-13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruce as applied to claim 1 above, and further in view of Basso (US 4,517,815). Bruce does not teach multiple sections being combined to form the enclosed space.

In the patent Basso teaches an insulated modular cooler having a plurality of tubular housing sections and a plurality of tubular hollow-walled insert housings containing a refrigerant in the hollow walls of the insert housings. The tubular housing sections can be secured end to end to form an elongated tubular body into which the tubular insert housings are slidably received. The cooler further comprises a top end cap adapted to engage the top of the tubular cooler body as well as the top of each individual cooler housing sections, and a lower end cap adapted to engage the bottom of the tubular body as well as the bottom of each individual cooler housing section. See figures 1-3 teaching that the disadvantages associated with prior art devices when the size of the cooler is not close the size of the material being stored is overcome by providing an insulated modular cooler having a plurality of detachable housing sections, each section comprising a tubular member having hollow walls and containing a refrigerant in the hollow walls. The sections are attached end to end so as to provide one or more cooled compartments adapted to fully enclose the containers or other products therein. Moreover, as products contained in each section are consumed, the section can be detached from the remaining sections so as to reduce the bulk of the cooler as the contents are consumed. The cooler housing sections (12,14,16) each include an insert housing (22,24,26). The inner bores of the tubular insert housings communicate end to end so as to form a central cooling chamber (28) throughout the cooler (10). The annular walls of each of the insert housings define a hollow annular chamber within each insert housing body. The closed chambers are filled with a gel (29), water or other refrigerant to be frozen when the insert housing is placed in a conventional freezer or other cooling apparatus. The insert housings are identical, but are separately designated for clarity in defining the position of the insert housings within the cooler. One end of a tubular wall (30) includes a recessed, tubular end portion (32). The recessed end portion includes external threads (34) adapted to mate with corresponding internal threads on a sleeve wall portion (38) of a cap member (18) or an extended sleeve portion (42) in the other end of the tubular wall. Column 4 lines 11 to 16 teach it is to be understood that the cooler body need not be cylindrical

and other means for securing end caps in place, such as a tongue and groove arrangement, are also possible.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the modular sections of Bossa into the structure of Bruce and incorporate a tongue and groove mechanism to connect them as taught by Bossa because of the ability to vary the size of the cooled compartment depending on the amount or size of the material being transported or stored and adapt the cooled space to efficiently cool the materials as taught by Bossa.

9. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruce as applied to claims 1 or 5 above, and further in view of Drake (US 3,858,410) or Malach (US 6,482,332). Bruce does not teach an ethanol water mixture or butanediol mixture as the solidifiable substance.

In the patent Drake teaches a combination dental material mixing slab holder and cooler which includes a base plate having a pair of spaced, upwardly projecting ribs for receiving a mixing slab and a central well, a sealed container in said central well and a reusable heat sink means within said sealed container. Column 2, lines 8-20 teach that the heat sink means is a stable liquid or solid material, having a relatively high latent or sensible heat capacity. Preferably the material has a latent heat capacity and undergoes a phase change at a temperature below ambient, such as water, water-ethanol solutions containing up to about 50 percent by volume ethanol, various brines and the like. Exemplary of the brines that can be utilized is an aqueous solution containing about 25 weight percent sodium chloride, an aqueous solution containing about 25 weight percent calcium chloride and the like.

In the patent Malach teaches various phase change formulations usable in thermal packaging systems using a single phase change material (PCM) part in liquid and part in solid form to confine the temperature of the product within a predetermined range. The temperature ranges are determined by the selection of PCM formulation. The phase change materials selected have high latent heats of fusion and maintain relatively constant temperatures as they change phase. This permits light weight packaging with the maintenance of temperatures in narrow, preselected ranges over extended periods of time. A phase change formulation that can be adjusted to freeze at temperatures from +40 °C. to below -30 °C. is disclosed, comprising

butanediol, selected percentages of distilled water, and nucleating agents. The phase change occurs over a narrow temperature range making this an ideal temperature control media. Nucleating or other agents are included to narrow the temperature range over which the phase change occurs. Column 3, line 60 to column 4, line 4 teach various goods such as biological products, blood products, vaccines, pharmaceuticals, chocolate products; latex paints with specific examples including whole blood 1 to 10 °C., Factor VIII (used by hemophiliacs) 2 to 8 °C., diagnostic blood samples 1 to 10 °C., some vaccines 2 to 10 °C., blood platelets 20 to 24 °C., and chocolate approximately 10 °C for storage by the system under controlled product temperatures. Columns 8-12 give several examples of compositions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ethanol water and butanediol water compositions of Drake or Malach into the device of Bruce because of their use for similar systems and products as taught by Drake and Malach.

10. Claims 11, 14 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruce or Bruce in view of Bossa as applied to claims 1-3 and 12 above, and further in view of Sheehan (US 4,322,954), MacDonald US 5,058,397) or Schea, III (US 5,181,394). Bruce does not teach a latch, eyelet, hinge, carrying strap or thermometer.

In the patent Sheehan teaches a portable cooler for medicine that contains a material to maintain the temperature of the contents at a desired level. The device includes a carrying strap (14) and latches (20).

In the patent MacDonald teaches a cryogenic storage container for biological specimens that includes a cooling gel or medium to keep the specimens at a temperature below ambient. The device includes a hinges (22,33) and latches (25,37).

In the patent Schea, II teaches a freeze protective shipping container for containers of liquid compositions, such as solutions of biologically active proteins, which are susceptible to physicochemical change upon freezing. Preferred container holders have double sidewalls and a freeze indicator adjacent a container-accommodating cavity. A phase change material such as a carboxymethylcellulose gel is disposed in the enclosed space between sidewalls and freezes at a temperature higher than the nucleation temperature of the composition. A freeze indicator

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provides an irreversible visual signal upon reaching a temperature intermediate the nucleation temperature of the liquid composition and the freezing temperature of the phase change material. Column 4 lines 52-64 teach that the freeze indicator may have a variety of conformations and its only operational constraint is that it provide an irreversible visual signal indicative that a particular low temperature has been reached in the space where the vials are disposed. Thus, thermocouple devices of varying kinds and simple devices such as described in U.S. Pat. No. 4,191,125 are quite suitable as the freeze indicators.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a structure such as the latch of Sheehan or MacDonald or another known closure structure into the Bruce device because of its known ability to provide a secure closure which Bruce teaches might be desirable in some circumstances. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the hinge of MacDonald, the carrying strap of Sheehan or the temperature indicator of Schea, III into the Bruce device because of the ability to transport the device as taught by Sheehan, the benefits of a hinge as taught by MacDonald or the ability to monitor the temperature and determine if it has gone beyond the desired temperature range as taught by Schea, III.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additionally cited art relates to containers having cooling agents therein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arlen Soderquist whose current telephone number is (571) 272-1265 as a result of the examiner moving to the new USPTO location. The examiner's schedule is variable between the hours of about 5:30 AM to about 5:00 PM on Monday through Thursday and alternate Fridays.

A general phone number for the organization to which this application is assigned is (571) 272-1700. The fax phone number to file official papers for this application or proceeding is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



June 22, 2004

ARLEN SODERQUIST  
PRIMARY EXAMINER

<b>Notice of References Cited</b>	Application/Control No. 10/022,406	Applicant(s)/Patent Under Reexamination NEHRING ET AL.	
	Examiner Arlen Soderquist	Art Unit 1743	Page 1 of 2

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	B	US-3,802,220	04-1974	Pompo, Thomas B.	62/530
	C	US-3,834,456	09-1974	Clarke et al.	165/104.17
	D	US-3,858,410	01-1975	Drake, Daniel H.	62/458
	E	US-3,940,249	02-1976	McClurg, James E.	436/174
	F	US-4,322,954	04-1982	Sheehan et al.	62/371
	G	US-4,357,809	11-1982	Held et al.	62/457.4
	H	US-4,498,312	02-1985	Schlosser, Edward P.	62/457.2
	I	US-4,517,815	05-1985	Basso, Peter J.	62/457.5
	J	US-5,058,397	10-1991	MacDonald, Richard E.	62/457.2
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	B	US-6,169,247	01-2001	Craft et al.	174/15.1
	C	US-6,209,343	04-2001	Owen, Donald R.	62/457.2
	D	US-6,361,746	03-2002	Wlodarski, Julie Ann	422/104
	E	US-6,482,332	11-2002	Malach, Ted J.	252/70
	F	US-			
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	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

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